

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.

233

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

F. RICHARD CHRIST, DAVID A FENCIL
and PATRICIA M. KNIGHT
Junior Party¹

v.

LARRY W. BLAKE
Senior Party²

Patent Interference No. 103,435

Before URYNOWICZ, CAROFF and CRAWFORD, Administrative Patent Judges.

¹Serial No. 07/547,859, filed July 3, 1990, now Patent No. 5,147,397, issued September 15, 1992. Assigned to Allergan, Inc.

²Serial No. 07/900,053, filed July 27, 1992. Accorded benefit of Serial No. 07/705,771, filed May 28, 1991, now Patent No. 5,185,107, issued February 9, 1993; and Serial No. 07/262,985, filed October 26, 1988, now Patent No. 5,104,590, issued April 14, 1992. Assigned to Iovision, Inc.

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CRAWFORD, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

The invention at issue in this interference relates to an intraocular lens. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

An intraocular lens comprising;
an optic; and
at least one haptic including a lens
bonding region bonded to said optic,
wherein said lens bonding region is exposed
to corona discharge or to plasma prior to
being bonded to said optic, and the bond
strength between said haptic and said optic
is increased as a result of said exposure
relative to a substantially identical
intraocular lens including a haptic the
lens bonding region of which is not
subjected to said exposure.

The claims of the parties which correspond to this count are:

Christ et al.: Claims 1 through 17.

Larry Blake: Claims 137 through 140.

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Involved U.S. Patent 5,147,397 to Christ issued on September 15, 1992 and was filed on July 3, 1990. This interference was declared on July 25, 1994. At that time Larry Blake was accorded the benefit of U.S. Serial No. 07/705,771, filed May 28, 1991, which matured into U.S. Patent No. 5,185,107 on February 9, 1993; and U.S. Serial No. 07/262,985 filed on October 26, 1988, which matured into U.S. Patent No. 5,104,590 on April 14, 1992, and was accorded senior party status on that basis. Involved application Serial No. 07/900,053 to Blake was filed on July 27, 1992.

The following motions are before us for review:

(a) The Senior party's two motions under 37 CFR § 1.642 to redefine the interfering subject matter by adding two Christ patents to the interference (Paper Nos. 25 and 26).

(b) The Senior party's contingent motion for judgment pursuant to 37 CFR § 1.633(a) on the ground that Christ claims 1 through 17 are unpatentable under 35 U.S.C. § 102(e) over U.S. Patent No. 5,104,590 (Paper No. 38).

(c) The Senior party's contingent motion for judgment pursuant to 37 CFR § 1.633(a) on the ground that Christ claims

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1 through 17 are invalid under 35 U.S.C. § 132 over prior art (Paper No. 39).

(d) The Senior party's contingent motion for judgment pursuant to 37 CFR § 1.633(a) on the ground that Christ claims 1 through 17 are unpatentable under 35 U.S.C. § 112 (Paper Nos. 40 and 41).

(e) The Junior party's motion for judgment pursuant to 37 CFR § 1.633(a) on the grounds that the Blake claims are unpatentable for inequitable conduct (Paper No. 51).

(f) The Senior party's motions under 37 CFR 1.635/1.618(a)/1.645 regarding the admissibility of evidence submitted by Christ (Paper Nos. 94 and 101).

(g) The Senior party's motion under 37 CFR § 1.635 to grant leave to file a belated 37 CFR § 1.633(a)/35 U.S.C. § 102(f) motion (Paper Nos. 113 and 114).

(h) The Senior party's motion under 37 CFR § 1.635 for a surrebuttal period (Paper No. 150).

The Senior Party's 37 CFR § 1.642 motion

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In the final brief of the Senior party Blake argues that the Administrative Patent Judge ("APJ") should have decided the Senior party's 1.642 motions (Papers Nos. 25 and 26) to add Christ U.S. Patent No. 5,262,097 and U.S. Patent No. 5,344,449 to this interference. The APJ dismissed the motion (Paper No. 77) and a panel of the board denied a Request for Reconsideration (Paper No. 81). The Senior party requested certification to petition the Commissioner but this was also denied (Paper No. 79). The Court of Appeals for the Federal Circuit dismissed a mandamus action.

We initially note that 37 CFR § 1.635 states:

A party seeking entry of an order relating to any matter other than a matter which may be

raised under § 1.633 or § 1.634 may file a motion requesting entry of the order.

The Senior party's 1.642 request to have two Christ patents added to the interference seeks the entry of an order and as such the request is a motion. Further, the addition of the Christ patents is not a matter which may be raised under §

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1.633 or

§ 1.634 and as such, in our view, the motion to add the Christ patents is a miscellaneous motion pursuant to 37 CFR § 1.635. We note that the Senior party has also referred to the request as a motion (see page 1 of each request).

A motion under 37 CFR § 1.635 must contain a certificate by the moving party stating that the moving party has conferred with all opponents in an effort in good faith to resolve by agreement the issues raised by the motion. The motion of the Senior party did not contain a certificate as required and as such was properly dismissed by the APJ.

The Senior Party's Conception and Reduction to Practice

The Senior party alleges a conception date of August 1987. This conception is corroborated by Gene Currie, who is a friend, colleague and business associate of Larry Blake. Gene Currie testified that he and Larry Blake were discussing the problem of attaching haptics to optics and Larry Blake suggested using corona discharge as it had been used for surface treatment of plastics and rubber to improve adhesion. Gene Currie also testifies that Larry Blake decided to use the

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technique to see if it could be used to attach haptics to molded silicone rubber (Blake Record ("B.R.") 0411-0412). Gene Currie, although not stating an exact date, states that this occurred on or shortly before August 1987 (B.R. 0412). Gene Currie also corroborates reduction to practice in stating that the haptics were treated with corona discharge and then the haptic was attached to the optic on or before August 1987. (B.R. 0411-0412 and 0414-0415). Specifically, Gene Currie states:

What Larry did was to clean the surface of the polypropylene haptic, then treat it with the corona discharge wand (which oxidized the surface), . . . and then attach the haptic to the optic. [B.R. pages 0414-0415]

Dr. Nordan corroborates the conception and reduction to practice to the extent that he states that he observed an intraocular lens shown to him by Larry Blake that had haptics attached to optics without an anchor in approximately September or October of 1987 (B.R. 0637).

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The Junior party, although alleging derivation by the Senior party, has not specifically contested the Senior party's conception and reduction to practice date in their brief.

It is our view that the evidence of conception and reduction to practice is sufficient to establish a date of conception and reduction to practice for the Senior party of August 1987.

The Junior Party's Conception

Christ being the Junior party has the burden of proving prior inventorship by a preponderance of the evidence.

Peeler v. Miller, 535 F.2d 647, 651, 190 USPQ 117, 120 (CCPA 1976). In reviewing the record we have kept in mind that the testimony of an inventor is not by itself effective to prove conception and reduction to practice in the absence of corroboration. The purpose of the rule requiring corroboration is to prevent fraud and to establish by proof that is unlikely to have been fabricated or falsified, that the inventor successfully reduced his invention to practice. Berry v. Webb, 412 F.2d 261, 267, 162 USPQ 170, 174 (CCPA

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1969). The evidence necessary for corroboration is determined by the rule of reason which involves an examination, analysis and evaluation of the record as a whole to the end that a reasoned determination as to the credibility of the inventor's story may be reached. Berges v. Gottstein, 618 F.2d 771, 776, 205 USPQ 691, 695 (CCPA 1980); Mann v. Werner, 347 F.2d 636, 640, 146 USPQ 199, 202 (CCPA 1965). Although adoption of the "rule of reason" has eased the requirement of corroboration with respect to the quantum of evidence necessary to establish the inventor's credibility, it has not altered the requirement that corroborative evidence must not depend solely on the inventor himself or herself, and must be independent of information received by the inventor. Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981); Mikus v. Wachtel, 542 F.2d 1157, 1161-62, 191 USPQ 571, 575 (CCPA 1976).

Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." Hybritech Inc., v. Monoclonal Antibodies, Inc., 802 F.2d 1397,

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1376, 231 USPQ 81, 87 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987)(quoting 1 Robinson On patents 532 (1890)).

"Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his 'completed thought expressed in such clear terms as to enable those skilled in the art' to make the invention." Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985); Field v. Knowles, 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950). Furthermore, the inventor must show that he or she was in possession of every feature of the count. Colman v. Dines, 754 F.2d at 359, 224 USPQ at 862; Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1069 (CCPA 1980).

With respect to conception, the brief of Christ refers to the following evidence:

- (1) The First Richard Christ Declaration (Christ Record ("C.R.") 0206);
- (2) The First Patricia Knight Declaration (C. R. 0001);
- (3) Christ Exhibit 5;
- (4) The First Dean Pettit Declaration (C. R. 0084);
- (5) The Dean Pettit Deposition (C. R. 0137, paragraphs 8

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through 22); and

(6) The Kenneth Mayhan Declaration (C. R. 156-157.

Richard Christ's notebook (Christ Exhibit 5) which is dated January 25, 1985 to June 25, 1985, has a section entitled "Methods to Improve the Bond between Elastomeric Silicone and Embedded Haptic Materials" and list several "methods" including plasma treatment of the anchor region.

In the First Christ Declaration (C. R. 0208), Richard Christ states that he, Patricia Knight and Dave Fencil jointly came up with a workable idea for using plasma and corona to enhance the bonding of the haptic in the manner set forth in the above count.

Dean Pettit states in his declaration (C. R. 0085) that from approximately 1983 through approximately mid 1987, he worked along with Richard Christ, Patricia King and others on projects relating to ways of attaching haptics to optics of intraocular lenses including using plasma and corona discharge to treat the haptics. Dean Pettit states in his deposition (C. R. 0137) that he initialed the Christ notebook (Christ

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Exhibit 5; C.R. 0088). Dean Pettit also states that in approximately 1985, Christ and Knight suggested treating haptics with plasma or corona discharge (C.R. 0086).

The Senior party argues that the conception document is far too general to constitute a conception of the invention defined by the count but rather at most indicates an avenue of potential research.

We do not agree with the Senior party. The Christ Notebook (Christ Exhibit 5) indicates that one of the methods to improve the bond between elastomeric silicone and embedded haptic materials was plasma treatment of the anchor region. It also states that pretreatment of the polypropylene region would directly precede the silicone bonding and that this pretreatment should be by plasma. These laboratory entries are dated from January 1985 through June 1985.

It is our view that the entries in the notebook contain sufficient detail to establish that the Junior party had in mind a definite and permanent idea of the complete and operative invention.

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The Senior party states that the declaration of Kenneth Mayhan is indefinite as to dates and lacks details. Although the Kenneth Mayhan declaration does indicate that the Christ conception took place in the 1985-1987 time frame, Dean Pettit states:

So in approximately 1985, I recall that Rich Christ and Patricia Knight suggested we try to treat the haptics with plasma or corona discharge as set forth in the counts of the present interferences attached hereto. [C.R. 0086]

As such, it is our view that this testimony is sufficiently definite as to date so as to corroborate the conception of the invention by the party Christ in 1985.

Derivation by the Senior party

The Junior party alleges that Larry Blake derived the invention from the Junior party. The Junior party alleges that Larry Blake knew about the invention because he was present at the laboratory where the testing of the invention was taking place. It is also the Junior party's contention that the invention was communicated to Larry Blake while he

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worked as a consultant at Allergan from June 1986 and until April 1987, by Kenneth Mayhan.

In order to establish derivation, the Junior party must show (1) prior, complete conception of the claimed subject matter and (2) communication of the complete conception to Larry Blake. Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974).

In regard to the Junior party's argument that Larry Blake must have known about the plasma and corona work on haptics and optics because of his presence in the laboratory where testing on the haptic optic connection was being conducted, the evidence shows that Larry Blake began as a consultant with Allergan in June of 1986, and concluded as a consultant in April 1987. During that period, Larry Blake was a consultant in the area of research and development relating to silicone lenses at Allergan. In this capacity, Larry Blake worked on different projects at Allergan (C.R. 0461).

Jim Davenport, a manager at Allergan during the time Larry Blake was a consultant, testifies that Larry Blake had every opportunity to understand the treatment of haptics with

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plasma and corona (C.R. 0461). Stan Van Gent, a R&D engineer at Allergan during the time that Larry Blake was a consultant, testifies that there were no secrets in the R&D Department of Allergan during the mid-1986 time frame and that everyone shared resources. Stan Van Gent further testifies that he knew about the project and the roles of Richard Christ, Patricia Knight and David Fencil and that Larry Blake had full access to the plasma and corona technology in 1986 and would have been aware of it. Stan Van Gent also testifies that Larry Blake's exposure at Allergan and his dealings with the other individuals involved in R&D at Allergan gave him the opportunity to understand the methods and techniques used at Allergan to bond haptics to optics including plasma and corona discharge as set out in the count (C.R. 0366). Ralph Kafesjian, an engineer that worked at Allergan at the time that Larry Blake was a consultant, testifies that it was common knowledge that plasma and corona work was being conducted in the Technology and Ventures laboratory. Ralph Kafesjian also testifies that he saw Larry Blake in the Technology and Ventures building at least once and that anyone

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could go in and out of the building freely (C.R. 0414). However, there is some confusion in the record about whether when the witnesses refer to the Technology and Ventures laboratory they are referring to the building itself or to the rooms in which the plasma and corona testing was taking place (C.R. 01760).

Larry Blake denies knowing about the corona and plasma work with haptics and optics while a consultant at Allergan. While the Junior party argues and Ralph Kafesjian testifies that it would not be possible for Larry Blake not to know about the plasma and corona work being performed, Gene Currie, Mario Maricevic and Carlos Gallastegui who also worked at Allergan during the period, testify that they were not aware of the plasma and corona work being done on the haptics and optics connection (Blake Record "B.R." 0409; 0611, 0545). In fact Gallestegui states:

I am not saying that the party Christ et al's witnesses are lying ... the way they were working on a plasma surface treatment alternative to mechanical anchors ... if they were, it must have been a very low key

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project and one that was not widely known
in the company. (B.R. 0545)

Further, Gene Currie who was a consultant at Allergan during the period that Larry Blake was a consultant, testifies that the Allergan staff was hostile toward Larry Blake and Gene Currie (B.R. 0408). This was also corroborated by Kenneth Mayhan who testifies that Larry Blake had a method of operating that he just simply did not like (C.R. 0183). This hostility might have lessened the opportunities Larry Blake had to learn about plasma and corona treatment of haptics.

Although Mark Tung testifies that Larry Blake recommended the use of plasma to join two inert materials, this does not establish that the invention was communicated to Larry Blake (C.R. 0532). We also note that there are no sign in and sign out sheets in the record to prove that Larry Blake entered the lab where plasma work was being done.

In view of the foregoing, it is our view that the Junior party has not proven that Larry Blake knew about the plasma and corona work being done at Allergan just by virtue of his position as a consultant at Allergan.

We turn now to the Junior party's argument that the invention of the Junior party was directly communicated to Larry Blake. The Junior party alleges the invention was communicated by Kenneth Mayhan. Kenneth Mayhan testifies that he "generally discussed the plasma work we were doing on haptics with Blake" (C.R. 0157). Kenneth Mayhan does not testify about exactly what was discussed with Larry Blake. Larry Blake denies that this conversation ever took place or that he was ever in the Technologies and Ventures laboratory.

The Junior party has cited several reasons why Larry Blake's testimony about the communication about the invention should not be viewed as credible. The Junior party points to the fact that Mark Tung and Jim Davenport both testify that Larry Blake knew about plasma while at Allergan while Larry Blake testifies that he was not knowledgeable about plasma while at Allergan. The Junior party also points out that Larry Blake "acquired" a corona discharge instrument while working at Edward's Lab and stored the corona discharge instrument in his garage and that Larry Blake was a defendant in a trade secret lawsuit with a former employer.

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However, none of these facts proves that Larry Blake is not credible. More importantly, there is no evidence on the record about exactly what was communicated by Kenneth Mayhan. Therefore, even if we found that Kenneth Mayhan more credible than Larry Blake, the Junior party has not established that Mayhan communicated a complete conception of the invention to Larry Blake. See Hedgewick v. Akers, 497 F.2d at 908, 182 USPQ at 169. For these reasons, we hold that the Junior party has not proven that Larry Blake derived the invention from Richard Christ, Patricia Knight and David Fencil.

As we have determined that the Junior party has not proven derivation, the Senior party's motion for a surrebuttal period to obtain testimony concerning a lawsuit in which Larry Blake was a defendant and the Senior party's motion to exclude the evidence relating to the lawsuit is moot.

We will not address the various objections to evidence contained in the Senior party's 37 CFR § 1.656(h) motion, as we have determined that even if the evidence objected to is admitted, the Junior party has still failed to prove derivation.

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The Senior party argues that in the motion filed under 37 CFR §§ 1.635/1.618(a)/1.645(b) (Paper No. 94) that the Stan Van Gent declaration should not be admitted as evidence. As we have determined that the Junior party has not established that Larry Blake derived the invention from the Junior party even if the Stan Van Gent declaration is considered, we will not reach this issue.

Christ's reduction to practice

In support of the claim to a reduction to practice prior to the filing date of the Senior party, the Junior party Christ relies on the notebook of David Fencil which describes test in which loops were plasma treated and immediately removed to air and placed in molds (Christ exhibit 16). One portion of the notebook, which states that the plasma treated loops were fabricated and were not easily removed from the silicone is dated October 9, 1986. Another section of the notebook dated January 20, 1987, indicates that molds were made in the form of one centimeter discs with grooves for loops and that these loop grooves were the same size as the loop grooves on lens

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molds. Silicone was added, the molds closed and clamped and the silicone cured then removed from the oven and cooled in water.

Christ offers the declarations of Dean Pettit (C.R. 092) and Kenneth Mayhan (C.R. 0156-057) as corroboration of this reduction to practice. Kenneth Mayhan states:

I remember reviewing the plasma-treated haptics and observed the improved wetting that they exhibited. I was aware of the improved adhesive properties both because I was informed by the Allergan people and because of my own personal knowledge that the plasma treated loops I observed exhibited, improved or increased bond strength relative to the loops which were not plasma treated in the 1986-1987 time frame. [C.R. pages 0156-0157]

The Pettit declaration states that Dean Pettit is familiar with the Fencil's lab notebook and witnessed their efforts to show the usefulness of plasma treating to enhance the optic/haptic bond strength. Dean Pettit specifically states:

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I distinctly remember looking at SEM photos
of etched haptics . . . I remember the
apparatus used to measure the pull strength
. . .

I remember and can corroborate the information
in the lab notebooks indicating that the test
results were positive and that plasma treating
did indeed improve the bond strength. [C.R.
0092-0093]

It is our view that the evidence establishes that the
Junior party did reduce the invention to practice. However,
the Dean Pettit testimony does not mention dates and the
Kenneth Mayhan declaration only states that this reduction to
practice occurred in the 1985 to 1987 time frame. As such, in
our view, the evidence is only effective to corroborate a
reduction to practice as of the last day of 1987 or December
31, 1987. In this respect, the date of the notebook entries
dated October 9, 1986 has not been corroborated. See Jepson
v. Egly, 231 F.2d 947, 952, 109 USPQ 354, 358 (CCPA 1956).

The Senior party argues that Christ does not allege that
it attached haptics to optics using plasma prior to its filing

date. We do not agree. The Fencil notebook clearly states that disc or optics were attached to loops or haptics:

Molds were made in the form of discs with grooves for loops.

The disc was 1 cm. in diameter. The loop grooves were the same size as the loop grooves on lens molds.

Loops were made in the normal S1-20B configuration and also without the accumulator. . .

Both types of loops protruded into the mold (and also the lens) approximately 0.40". . .

The loops were plasma treated under the following condition:

80 watts

30 minutes

13.8 MegaHertz

Immediately after the plasma treatment, the loops were removed to air and placed in the molds. Silicone (LSM-1) was added, the molds closed and clamped. This operation, for all ten molds took 30 minutes. The silicone was cured for 15 minutes at 150 C then removed from the oven and cooled in water. [Christ Exhibit 16]

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In view of the foregoing, it is our finding that the Junior party reduced the invention to practice not earlier than the last day of 1987 or December 31, 1987.

The diligence of Christ's reduction to practice

Now that we have found that Richard Christ conceived the invention in 1985 and reduced the invention to practice on December 31, 1987, we must determine whether the Junior party was diligent from just prior to the date of the Senior party's conception, August 1987, to the Junior party's own subsequent reduction to practice, December 31, 1987. Diligence, within the meaning of 35 U.S.C. § 102(g) requires continuous activity during the critical period. Burns v. Curtis, 172 F.2d 588, 591, 80 USPQ 587, 589 (CCPA 1949). To satisfy the reasonable diligence requirement of 35 U.S.C. § 102(g), the party chargeable with diligence must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Evidence of diligence during the critical period may be shown either by affirmative acts or acceptable excuses or reasons for failure of action. Hull v.

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Davenport, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937).

The Junior party has not addressed this issue in its main or reply brief. However, the evidence shows that between October 9, 1986 and February 2, 1987, Fencil performed a series of experiments on the invention (Christ Exhibit 4). The evidence also indicates that on June 22, 1988, Richard Christ sent a memo to various people in R&D at Allergan informing them of the status of the loop bonding project (Christ Exhibit 14). The memo does not discuss the critical period from just before August 1987 until December 31, 1987. The Junior party has also filed an interoffice memo dated December 5, 1988. However, this memo also fails to mention the critical period between just prior to August 1987 and December 31, 1987. The Junior party has not directed our attention to any evidence that shows diligence from just prior to August 1987 to December 31, 1987.

Therefore, it is our conclusion that the Junior party has not established diligence during the critical period.

As we have determined that the Junior party has failed to establish diligence during the critical period the issue

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raised in the Senior party's motion under 37 CFR §§ 1.635/1.618(a)/1.645(b) regarding the admissibility of Christ evidence is moot.

The Junior party's allegation of inequitable conduct by
Larry Blake

The Junior party argues that the Senior party's failure to disclose to the Patent and Trademark Office the prior invention of the Junior party is inequitable conduct. The Junior party also argues that the Senior party had constructive knowledge of the prior invention of Christ because when Larry Blake first brought the Larry Blake disclosure to the law firm of Knobbe, Marten, Olson and Bear ("Knobbe"), the Knobbe law firm had already received the Christ disclosure. In addition, the Junior party states that there was an apparent "mingling" of the files because a corona brochure which Larry Blake remembers giving to the Knobbe firm was found in the Christ application. The Junior party further alleges that the Knobbe firm conducted a literature search on the publications of Dr. Mayhan, who was the director of the Technology and Ventures laboratory in which the Junior party

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conducted experiments in which haptics were treated with plasma. The Senior party argues that the Junior party has not proven that any individual had knowledge that the Christ disclosure was in the Knobbe office or that any individual had an intent to deceive the PTO.

A determination of inequitable conduct is committed to our discretion. Critikon, Inc. v. Becton Dickinson Vascular Access, Inc., 120 F.3d 1253, 1258, 43 USPQ2d 1666, 1670 (Fed. Cir. 1997). In order to convince us to exercise our discretion and hold that conduct amounts to "inequitable conduct," a party must show that its opponent:

(1) made an affirmative misrepresentation of fact or failed to disclose a fact;

(2) the fact misrepresented or not disclosed was material; and

(3) the misrepresentation or failure to disclose was done with an intent to deceive or mislead the Patent and Trademark Office. Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178, 33 USPQ2d 1823, 1826 (Fed. Cir. 1995). The party alleging

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inequitable conduct on the part of its opponent bears a burden of proving its case by clear and convincing evidence. Refac Int'l, Ltd. v. Lotus Dev. Corp., 81 F.3d 1576, 1581, 38 USPQ2d 1665, 1669 (Fed. Cir. 1996). In the present case, we note that the court in Molins PLC v. Textron, Inc., 48 F.3d at 1181, 33 USPQ2d at 1829 stated:

Thus, the alleged conduct must not amount merely to the improper performance of, or omission of, an act one ought to have performed. Rather, clear and convincing evidence must prove that an applicant had the specific intent to accomplish an act that the applicant ought not to have performed, *viz.*, misleading or deceiving the PTO. In a case involving nondisclosure of information, clear and convincing evidence must show that the applicant made a deliberate decision to withhold a known material reference.

We have determined that the Junior party has failed to establish that the invention was communicated to Larry Blake

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while he was a consultant at Allergan and thus have determined that the Junior party has failed to establish that Larry Blake derived the invention from the Junior party. As such, the first rationale advanced by the Junior party to prove inequitable conduct fails. As for the allegation that the Senior party had constructive notice of the invention by virtue of the Knobbe firms representation of the Senior party and the Junior party contemporaneously, we are unconvinced that the actions of the Knobbe law firm should be attributed to the Senior party. In addition, it is our view that the Junior party has failed to prove an intent to deceive or mislead the United States Patent and Trademark Office ("PTO") as there is no evidence that establishes that any person at the Knobbe law firm, much less the Senior party Larry Blake, had an intent to deceive or mislead the PTO. The presence of the Larry Blake brochure in the Christ file does not itself establish this intent because there is no evidence of how it got there and who knew it was there. After all, the brochure could have been placed there in error by the clerical staff at the Knobbe firm.

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For the foregoing reasons, we find that the Junior party has failed to prove inequitable conduct by the Senior party.

The issue of suppression and concealment

The Senior party argues that Christ suppressed and concealed the invention. However, as we have found that the Junior party was not diligent in reducing the invention to practice, this issue is moot.

Blake's 37 CFR § 1.633 motions

The Senior party Larry Blake argues that the Junior party's claims 1 through 17 are unpatentable under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,104,590. In view of our determination that the Junior party has failed to establish diligence, this issue is moot.

The Senior party also argues in a 1.633 motion pursuant to 35 U.S.C. § 132 that the change that was made by an examiner's motion in a table which reported pull strengths for the haptics from 122 to 112 was new matter and therefore invalidates the Christ patent. In view of our determination that the Junior party has failed to establish diligence, this issue is moot.

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The Senior party filed a preliminary motion which alleged that the Junior party Christ's claims 1 through 17 are unpatentable under 35 U.S.C. § 112. In view of our determination that the Junior party has failed to establish diligence, this issue is moot.

The party Larry Blake has asked us to consider a 37 CFR § 1.635 motion for leave to file a belated 37 CFR § 1.633(a)/35 U.S.C. § 102(f) motion. In view of our determination that the Junior party has failed to establish diligence, this issues is also moot.

Christ's October 20 1995 filing

On October 25, 1995, the Junior party filed witnesses declarations and an index of witnesses and exhibits relied upon under Rule § 1.671 and § 1.672. The Senior party filed a motion arguing that the documents i.e., Christ's exhibits 14 and 15, declaration of Robert Bishop, Second declaration of F. Richard Christ were not timely filed.

As we have not based our decision on the Bishop declaration or exhibits 14 and 15, this issue is moot.

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Judgment

The Senior party has established a conception and reduction to practice of August 1987. The Junior party has failed to show diligence between the period just prior to August 1987 and the reduction to practice date established for the Junior party of December 31, 1987. Therefore, judgment is herein entered against the Junior party Christ. Accordingly, Christ, Fencil and Patricia Knight are not entitled to claims 1 through 17 of their application Serial No. 07/547, 859 which matured into U.S. Patent No. 5,147,397 which correspond to count 1. Judgment is herein awarded to Senior party Larry Blake. Larry Blake, on

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this record, is entitled to claims 137 through 140 of
application 07/900,053 which correspond to count 1.

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| STANLEY M. URYNOWICZ, JR. |) | |
| Administrative Patent Judge |) | |
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| MARC L. CAROFF |) |) |
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| MURRIEL E. CRAWFORD |) |) |
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